

App. Serial No. 10/816,335
Docket No.: US030022

Remarks

Claims 1-31 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated February 7, 2007 indicated that claims 1-31 stand rejected under 35 U.S.C. § 103(a) over Pomiet (U.S. 6,230,178) in view of Monier (U.S. 5,745,398).

Applicant respectfully traverses the Section 103(a) rejection of claims 1-31 because the Office Action does not state the rejections in the manner required by 35 U.S.C. § 132. For example, the Office Action alleges that the Monier reference teaches that "an error correction parameter circuit is configured to store an initial value in the working register that is greater than the modulus value (col. 10, lines 11-20)" without identify what allegedly corresponds to "the working register" or "an initial value." Applicant has reviewed the cited portion of the Monier reference and, while the cited portions generally disclose that an error correction parameter is produced, they do not appear to correspond to the limitations directed toward a working register that is used in determining the error correction parameter and in the storage of the claimed initial value. Thus, Applicant is unsure of how the Office Action is asserting that the cited portions of the Monier reference are relevant. This portion of the Monier reference mentions four different registers, none of which appear to correspond to the claimed limitations. Due to this lack of specificity, Applicant is unable to determine which register the Office Action is alleging corresponds to the claimed working register. Applicant notes that under M.P.E.P. § 706 "The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Here the Office Action appears to be citing teachings from the Monier reference, which have no readily apparent correspondence to the claimed limitations, without clearly explaining how the Office Action believes the teachings correspond to the claimed limitations.

Thus, the Office Action has provided insufficient detail regarding the proposed combination of the Pomiet and Monier references to enable Applicant to judge the propriety of such a combination. For example, the Office Action does not specify which parts of the Monier reference are to be combined with the Pomiet reference. As such,

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Applicant is unable to discern how the Office Action is attempting to combine these teachings with Pommet and further, how these teachings allegedly relate to the claimed invention when viewed as a whole. In failing to state the rejections in a manner which allows Applicant to judge the propriety of the rejections, the Office Action has failed to comply with 35 U.S.C. § 132. Accordingly, the Section 103(a) rejection of claims 1-31 is improper and Applicant requests that it be withdrawn.

Applicant has attempted to understand the intent of the Office Action where possible, but in many cases Applicant has been unable to identify how the Office Action is asserting correspondence to each claimed limitation. In particular, the Office Action does not appear to acknowledge any distinctions between the independent claims and the limitations contained therein. For example, the Office Action groups independent claims 1 and 13 together, which contain different limitations, and then only addresses the limitations of claim 1. In another example, the Office Action groups independent claims 17 and 28 together, which contain different limitations, and then once again only addresses the limitations of one of the claims (*i.e.*, claim 17). Thus, the rejection of claims 13 and 28, as well as the rejection of claims 14-16 and 29-31 that depend from claims 13 or 28, are improper because the Office Action has not addressed each of the claimed limitations as is required.

The Office Action has also failed to provide adequate evidence of motivation or suggestion for the proposed combination. More specifically, the Office Action asserts that the motivation to combine the references would be to reduce the periods of time needed for the modular multiplication to take place. Applicant requests clarification how the cited discussion of figures 7A and 7B of the Monier reference is thought to be relevant when viewed with respect to the cited figure 2 of the Pommet reference. More specifically, the Office Action appears to be asserting motivation exists for modifying the cited circuit/process of the Pommet reference (*i.e.*, figure 2) using a circuit/process from the Monier reference (*i.e.*, figure 7 as applied to figure 1). These two circuits/processes are not equivalent in function. Thus, the proposed modification would cease to generate the error correction parameter used by the Pommet reference. Applicant submits that this combination would therefore render the figure 2 circuit of the Pommet unsatisfactory for its intended purpose of generating an error correction parameter. See Pommet, column 3, lines 40-55.

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Under M.P.E.P. § 2143.03, if proposed modification would render the reference being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, one skilled in the art would not be motivated as suggested by the Office Action and the rejections are improper.

Applicant submits that the Section 103(a) rejection of each dependent claim is improper due to the impropriety of the rejection of each of the independent claims as is discussed above. Notwithstanding, Applicant further traverses the Section 103(a) rejection of each dependent claim because the cited portions of the Pommet reference fail to correspond to numerous claimed limitations and because the Office Action's statements regarding the teachings of the Pommet reference are illogical. The impropriety of the rejection of selected ones of the dependent claims is discussed in detail as follows.

For example, regarding claims 2, 5, 18, the Office Action on one hand acknowledges that the Pommet reference does not disclose storing an initial value in the working register that is greater than the modulus value. In direct contrast, the Office Action then asserts that the Pommet reference teaches aspects relating to how and when the initial value is determined. Applicant submits that the Office Action appears to contradict itself regarding the alleged correspondence between the Pommet reference and the claimed invention. Applicant agrees with the Office Action's statement that the cited teachings of the Pommet reference do not teach the claimed limitations directed towards the storing of an initial value. Accordingly, the Pommet reference does not teach correspondence to the specific limitations of claims 2, 5 and 18. Accordingly, the Section 103(a) rejection of claims 2, 5, and 18 is improper and Applicant requests that it be withdrawn.

In another example, regarding claims 19-20, the Office Action cites to item 202 of Pommet as corresponding to the claimed state machine; however, the cited portions of the Pommet reference identify item 202 as a register. *See, e.g.*, Figure 2 and Col. 4: lines 39-50. It is illogical to assert that a register would determine the most significant bit of the modulus value as does the state machine of the claimed invention. Therefore, the Section 103(a) rejection of claims 19-20 is improper and Applicant requests that it be withdrawn.

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In view of the remarks above, Applicant believes that each of the rejections has been overcome and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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